

embodiment, as described at pages 7-12 of the specification, such that present restriction requirement is inappropriate.

Applicant would like to point out that the “at least one connector” of claim 1 merely serves as a representative “second means” of claim 21, as indicated by paragraph [0026] of the present specification. All pending claims in the present application relate to a foldable vehicle top, which by definition is capable of moving between a roof closed position and a roof open position. Therefore, there is no basis for the position that the first means of claim 21 is an essential characteristic of this claim, particularly in view of the fact that no evidence has been provided to establish that such “moving” means imparts patentability to claim 21.

Consequently, in view of the principle stated in MPEP 806.03, specifically that restriction should “never” be required when the claims define the same essential characteristics of a single disclosed embodiment, the restriction requirement should be withdrawn.

The Separate Classification of Groups I and II Does Not Appear to be Warranted

Claims 21-25 have been preliminarily classified in Class 296, Subclass 107.12, which covers “Subject matter wherein the top includes a device for regulating a tautness in the pliable material of the top.” However, no factual explanation was provided as to why this classification is appropriate for claims 21-25 and entirely inappropriate for claims 1-20.

If the first means of claim 21 were considered to constitute a device for “regulating” the tautness of the pliable material of the top, it is noted that in paragraph [0026] of the present specification, a foldable frame or a folding top kinematic linking assembly are expressly stated as being “representative first means”. Thus, the first means recited in claim 21 does not support the asserted classification.

On the other hand, the second means of claim 21 is recited as functioning with a tensioning bow, which does serve to regulate the tautness of the pliable material. Therefore, even if Class 296, Subclass 107.12 is still believed to be the correct classification for claims 21-25, it should be noted that claim 1 in fact recites “a tensioning bow arranged and constructed to impart a tension across a rear portion of the roof covering...”. In other words, the tensioning bow recited in claims 1-20 is capable of regulating the tautness of the pliable material.

Thus, if it is contended that claims 21-25 are directed to a device for regulating a tautness of the pliable material, reasons should be stated as to why the tensioning bow of claim 1 is not

such a device for regulating the tautness of the pliable material. In the absence of any evidence to the contrary, Applicant believes that claim 1 should also be properly classified in Class 296, Subclass 107.12.

If it is determined that Class 296, Subclass 107.12 is applicable to claim 1, a separate classification (or separate status in the art, as stated in paragraph 3 of the Office Action) has not been shown and the restriction requirement should be withdrawn for this additional reason.

Furthermore, it is noted that claims 1-20 have been preliminarily classified in Class 296, Subclass 107.07, which covers “Subject matter wherein the let-down type top includes a window displaced rearwardly of a windshield of the vehicle.” Claims 1, 21 and 24 all recite a “rear window.” Thus, it appears that this classification also covers all pending claims and the restriction requirement is again not supported by a proper separate classification.

As an alternative classification, it is noted that Class 296, Subclass 100.16 may possibly be an appropriate classification for claims 1-25, because it covers “Subject matter wherein the cover is made of a pliable material in a panel or web form to allow bending or flexing of the cover and the cover includes a device to fix the position of the cover to a framework or body of the vehicle.” Each of claims 1, 21 and 24 includes a device or method step to fix the position of the cover to a framework and thus, Class 296, Subclass 100.16 also appears to be an appropriate classification covering all pending claims.

In any event, a separate classification of groups I and II is not supported by the US Manual of Classification, because claims 1, 21 and 24 are believed to collectively fall within one or more of the same classification(s). Therefore, the separate classifications provided in paragraph 1 of the Office Action is not warranted.

More importantly, there has been no demonstration of any additional burden, let alone the “serious burden” required by MPEP 803, to a search and examination of all pending claims at this time. In view of the related aspects covered by Class 296, Subclass 107.07 and Class 296, Subclass 107.12 (and possibly Class 296, Subclass 100.16), a search in multiple classifications is expected for each group of claims. Consequently, since all classifications relevant to each of claims 1, 21 and 24 must be searched in order to provide a comprehensive search for any one of these claims, the Examiner has failed to establish a *prima facie* case of serious burden under MPEP 803 and the restriction requirement should be withdrawn for this additional reason.

MPEP 806.05(c) Has Not Been Satisfied

“Two-way” Distinctiveness Has Not Been Demonstrated

According to MPEP 806.05(c), “two-way distinctiveness” is required in order to establish sufficient grounds for making a restriction requirement. Thus, it is necessary to show (i) how the alleged subcombination has a utility different from the combination AND (ii) how the alleged combination has a utility different from the subcombination.

The restriction requirement only provides an allegation that the subcombination has a utility other than that of the combination and fails to provide any factual basis for demonstrating that the combination has a utility not shared with the subcombination. Consequently, the restriction requirement fails to provide sufficient evidence to satisfy the two-way distinctiveness requirement of MPEP 806.05(c).

As noted above, the subject matter of each of claims 1, 21 and 24 relates to a foldable top having a device capable of releasably securing the foldable top in the roof closed position. Foldable vehicle tops by definition are movable between a roof open position and roof closed position. Therefore, the foldable top of claim 1 (i.e., the alleged combination), which is inherently capable of moving between a roof open position and a roof closed position, can not have a different utility from the apparatus of claim 21 (i.e., the alleged subcombination), which expressly recites such a moving means for that purpose, or vice versa. In other words, there has been no demonstration or explanation as to how “combination I” has a different utility or purpose than “subcombination II,” as the lack of a moving means in claim 21 is a rather dubious basis for distinguishing the foldable (i.e., movable) top of claim 1.

Thus, Applicant submits that claims 1 and 21 have the same utility (i.e., removably covering a vehicle). The same analysis is therefore applicable to both claim 1 and claim 24.

MPEP 816 Also Has Not Been Satisfied

According to MPEP 806.05(c), an Examiner must “show” how the combination “does not require the particulars of the subcombination as claimed for patentability (to show novelty and nonobviousness)” (Emphasis added). In addition, according to MPEP 816, reasons for requiring restriction must be expressed in the Office Action.

Thus, MPEP 800 makes it clear that simply stating a legal conclusion is not sufficient to support a restriction requirement. In other words, it is not sufficient to merely identify a

difference between two groups of claims, because naturally not all differences result in patentability. Rather, MPEP 806.05(c) and 816 necessitate establishing how the asserted difference makes one group of claims patentable. Any other interpretation ignores the words “for patentability” in MPEP 806.05(c).

Therefore, the present restriction requirement fails to satisfy the requirements of MPEP 806.05(c) and 816, because the entire factual basis for demonstrating different utilities is stated as “The combination has a utility in other combinations such as means for moving partition.” Because the restriction requirement only states a legal conclusion without any factual support for “two-way” distinctiveness, the present restriction requirement lacks a *prima facie* factual basis for this additional reason.

Moreover, it is noted that the complete absence of factual support and analysis prevents the Applicant from properly responding to such factual basis for the restriction requirement. That is, because no information whatsoever has been provided concerning a factual basis and/or analysis for determining how the alleged combination has a utility that is different from the alleged subcombination, Applicant has no opportunity to assess the validity of such asserted basis for two-way distinctiveness. Thus, the failure to provide such information in the restriction requirement unfairly prevents Applicant from making a thorough and directed response to the Examiner’s factual basis for the restriction requirement.

Furthermore, as claims 1 and 21 are capable of covering overlapping subject matter and no factual basis has been provided for establishing why the first means of claim 21 is essential for patentability in spite of the fact that claim 1 covers a foldable top, the present restriction requirement appears to be arbitrary and capricious. According to MPEP 806.05(c)(II), “If there is no evidence that the combination A_b_{sp} is patentable without the details of B_{sp} , restriction should not be required.” (Emphasis added) Thus, there is an obligation to place on the record how the alleged combination claim is patentable and how the patentable features of the alleged combination claim are not present in the subcombination claim. Under MPEP 806.05(c)(II), a failure to provide such factual evidence implies that the restriction should not be made.

In addition, it is noted that the restriction requirement merely states “In the instant case, the combination I as claimed do not require the particular of means for moving of subcombination II.” While this conclusory statement points out that a difference exists between claim 1 and claim 21, Applicant does not deny that claims 1 and 21 have different scopes so as to

avoid violating MPEP 2173.05(n). According to USPTO practice, independent claims that do not have different scopes are objectionable on multiplicity grounds.

Therefore, because every independent claim must have a different scope according to USPTO practice, it is not sufficient to merely and conclusively state that two independent claims have different scopes as a basis for supporting a restriction requirement. Thus, the mere identification of the fact that claim 1 does not expressly recite a feature of claim 21 is not a legally and factually sufficient basis for making a restriction requirement under MPEP 800 and withdrawal of the restriction requirement is required for this additional reason.

There is No Demonstration as to how Claims 21-25 are Patentably Distinct from All of Claims 1-20, and more particularly Claims 4, 5, 19 and 20

According to the restriction requirement, claims 21-25 are asserted as being patentably distinct from all of claims 1-20. However, as noted above, the first means of claim 21 covers, in part, a foldable kinematic linkage assembly (see paragraph [0026] of the present specification) in accordance with Section 112, sixth paragraph. Therefore, the Examiner's attention is directed to claims 4, 5, 19 and 20, which have been assigned to Group I even though claims 4 and 19 expressly recite a folding top kinematic linking assembly.

Thus, claims 4, 5, 19, 20 of Group I appear to contradict the statement that "the combination I (i.e., claims, 4, 5, 19, 20) do not require the particulars of means for moving of subcombination II." Consequently, the restriction requirement fails to establish how claims 21-25 of Group II are patentably distinct from claims 4, 5, 19, 20 of Group I, because the above stated grounds for the restriction requirement do not appear to exist for these claims.

In the event that the restriction requirement is maintained, Applicant respectfully requests an explanation as to how MPEP 804 would be applied if the subject matter claims 4, 5, 19 and/or 20 were to be allowed in this application and claims 21-25 were then examined in a divisional application. Additionally, Applicant requests that a sufficient record be provided in this application so that no obviousness double patenting issue is created in future examination of the divisional application and/or future litigation concerning this subject matter.

MPEP 806.05(c) Warrants a Different Characterization of Claims 1-20 and 21-25

While it is reiterated that MPEP 806.05(c) has not been satisfied for the above-noted reasons, it also appears that MPEP 806.05(c) has been incorrectly applied. That is, claims 1-20 appear to be more properly characterized as the “subcombination” and claims 21-25 appear to be more properly characterized as the “combination.” In this regard, it is noted that claim 21 recites a rear window and a tensioning bow, similar to claim 1. However, the second means of claim 21, which includes as one example the connector of claim 1 (see paragraph [0026]), is broader than the connector feature of claim 1 in view of Section 112, sixth paragraph. Therefore, it is believed that claim 21 is more properly characterized as the “combination”, since it does not set expressly forth the details of the connector of claim 1.

Even if the Examiner disagrees that “two-way” distinctiveness must be shown, it must be further noted that there has not been any showing as to how the “subcombination” of claim 1 has a separate utility from the “combination” of claim 21. As was discussed above, all foldable tops for a convertible vehicle must be capable, by definition, of moving between a roof open position and a roof closed position or such a device would not be a “foldable convertible top.” Thus, it is respectfully submitted that claim 1 can not have a separate and distinct utility as compared to claims 21 and 24, because all of claims 1-25 are directed to the purpose of providing devices and methods for opening and closing a foldable convertible top.

Conclusion

Because claims 1-20 and 21-25 all read upon a single preferred embodiment and are expected to require a search in one or more of the same classifications, no “serious burden” exists for applying the restriction requirement in this case. Moreover, the Examiner is requested to consider (MPEP 806) how future prosecution and/or litigation concerning the claimed subject matter might be affected by maintaining this restriction requirement, in view of claims 4, 5, 19 and 20, which have been assigned to Group I. In any event, as an insufficient factual basis for establishing a *prima facie* case has been provided, Applicant has been unfairly placed in the position of being completely unable to assess the Examiner’s factual basis for this restriction requirement in order to specifically respond thereto. In view of the preceding, withdrawal of the restriction requirement appears to be the prudent course of action.

Finally, it is expressly noted that all the above arguments are independent and distinct from each other and any one argument is believed to be sufficient to require withdrawal of this restriction requirement. The fact that several detailed arguments have been asserted only underscores the inappropriateness of this restriction requirement. Such arguments are in no way intended to, and should not be interpreted to, narrow the interpretation of the present claims, which are entitled to their ordinary and common meaning, as no rejection affecting the patentability of the claims has been made. Thus, no prosecution history estoppel can arise from the present arguments.

Respectfully submitted,

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